

Serial No. 09/574,453  
Docket No. FJ-2000-004-US  
(MAS.001)

2

**REMARKS**

As a preliminary matter, Applicant's representative would like to thank Examiner Pham and Examiner Burnf for courtesies extended in the personal interview conducted on October 26, 2004. A formal Examiner's Interview Summary Record (PTOL-413) has not yet been mailed by the Patent Office. However, an informal copy of the interview summary (undated) was provided by the Examiner at the interview.

Applicant submits this Statement to comply with the requirements of M.P.E.P. § 713.04.

In the interview, the following was discussed:

**A. Identification of claims discussed:**

Independent claims 1 and 11.

**B. Identification of prior art discussed:**

U.S. Patent No. 6,573,927 to Parulski, et al.

U.S. Patent No. 6,453,071 to Ito, et al.

**C. Identification of principal proposed amendments:**

None.

Serial No. 09/574,453  
Docket No. FJ-2000-004-US  
(MAS.001)

3

**D. Brief Identification of principal arguments:**

Discussed the traversal arguments set forth in the Amendment under 37 C.F.R. § 1.111 filed on October 22, 2004.

Particularly, with respect to the rejection of claims 1-31 under 35 U.S.C. § 103(a) as being obvious over Parulski and Ito, Applicants' representative respectfully submitted that the Examiner's stated motivation for combining the references clearly would not lead the ordinarily skilled artisan to arrive at the claimed invention.

Applicants' representative submitted that the claimed invention has an additional advantage of avoiding wasting of the memory capacity of the recording medium (e.g., see Figure 2, page 3, lines 17-23, and page 21, lines 18-22), which is not mentioned or even contemplated by either Parulski or Ito.

That is, the claimed invention provides a method and device for printing a specific scene of a moving image without redundantly storing (i.e., duplicating), on the recording medium, the image data of the image to be printed, thereby avoiding wasting of the memory capacity of the recording medium (e.g., see Figure 2, page 3, lines 17-23, and page 21, lines 18-22).

Thus, Applicants' representative respectfully submitted that the Examiner's stated motivation is deficient in establishing a reasonable motivation for arriving at the claimed invention (i.e., that which the inventor has done).

On the other hand, even assuming *arguendo* that it would have been obvious to combine Parulski and Ito, Applicants' representative respectfully submitted that there are

Serial No. 09/574,453  
Docket No. FJ-2000-004-US  
(MAS.001)

4

elements of the claimed invention which clearly are not disclosed or suggested by Parulski or Ito, either alone or in combination, and therefore, respectfully traverse this rejection.

As the Examiner acknowledges, Parulski does not explicitly disclose that, if the subject file comprises a moving image file, the print designating information further includes scene specifying information for specifying a subject scene to be printed in the moving image file. Indeed, Parulski does not contemplate saving memory capacity on the storage medium (e.g., a memory card) such that a still image can be printed from a moving image stored on the storage medium (e.g., a memory card).

Similarly, Ito also does not disclose or suggest saving memory capacity on the storage medium (e.g., a memory card) such that a still image can be printed from a moving image stored on the storage medium (e.g., a memory card).

Applicants' representative respectfully submitted that "*selecting and extracting a specific scene from a moving file to be printed*", as allegedly taught by Ito, clearly is different than disclosing print designating information that includes scene specifying information for specifying a subject scene to be printed in the moving image file, according to the claimed invention.

Contrary to the claimed invention, Ito merely discloses that the camera can be used to select still images from the moving images and transmit both the moving images and the still images (i.e., the moving images and the still images are stored separately), not that print designating information is used to specify a subject scene to be printed in the moving image file, as claimed.

Serial No. 09/574,453  
Docket No. FJ-2000-004-US  
(MAS.001)

5

For the reasons outlined in the Amendment under 37 C.F.R. § 1.111 filed on October 22, 2004, Applicants' representative argued that it clearly discloses that the image data in the moving image data is duplicated or reproduced to produce the still image data, and indeed, is stored in two separate memory units 13 and 15.

For the foregoing reasons, Applicants' representative respectfully submitted that the prior art of record fails to disclose storing a print designation file in a recording medium in which a file including image data is stored that designates a still image to be printed which is stored in a moving image file stored in the recording medium, as claimed in independent claims 1, 11, 12, and 14-18, and 21, or for that matter even contemplate (or teach or suggest) reducing the wasting of memory capacity in the storage medium, according to one of the exemplary aspects of the claimed invention.

**E. Results of the Interview:**

The Examiners indicated that further consideration of the traversal arguments set forth in the October 22, 2004 Amendment would be necessary. Therefore, the Examiners did not comment on the allowability of the claims at the interview.

**F. Conclusion:**

In view of the foregoing, Applicants respectfully submit that claims 1-31 are patentable over the prior art of reference.

The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Serial No. 09/574,453  
Docket No. FJ-2000-004-US  
(MAS.001)

6

It is believed that no petition or fee is required. However, if the USPTO deems otherwise, the Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: December 31, 2004

  
John J. Dresch, Esq.  
Registration No. 46,672  
Sean M. McGinn, Esq.  
Registration No. 34,386

**McGinn & Gibb, PLLC**  
8321 Old Courthouse Road, Suite 200  
Vienna, VA 22182-3817  
(703) 761-4100  
**Customer No. 21254**

**CERTIFICATE OF TRANSMISSION**

I certify that I transmitted via facsimile to (703) 872-9306 the enclosed Statement of Substance of Interview to Examiner Thierry L. Pham on December 31, 2004.

  
John J. Dresch, Esq.  
Registration No. 46,672  
Sean M. McGinn, Esq.  
Registration No. 34,386